

### **Remarks**

The applicant has carefully considered the Office Action dated September 30, 2008, and the references cite therein. By way of this Response, claims 1, 3, 4 and 6 have been amended, and claims 8 and 9 are newly added. In view of the following, it is respectfully submitted that all of claims 1-9 are in condition for allowance and favorable reconsideration is respectfully requested.

#### **The 35 U.S.C. § 112 Objections**

The examiner objected to claims 1, 4 and 6 for informalities, and rejected claims 1, 2 and 6 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 4 and 6 have been amended to correct the informalities and to remove the basis for rejection of claims 1, 2 and 6. Accordingly, applicant respectfully submits that the objection for informalities and the rejection of claims based on 35 U.S.C. 112, second paragraph, should be withdrawn.

#### **The 35 U.S.C. § 103 Rejections**

The examiner rejected claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (US 6273887 B1) in view of Chen et al. (US 6102909). While applicant does not agree with the positions of the examiner that it would have been obvious to one of ordinary skill in the art to seek to combine Yamauchi and Chen, or that such a combination is feasible and would provide a device having all of the limitations of claims 1-7, applicant has amended independent claims 1 and 3 to further distinguish over the prior art.

In particular, applicant has amended independent claim 1 to require, in pertinent part, "a first jaw extending at an angle from a first elongated extension shaft and a second jaw extending at an angle from a second elongated extension shaft, the first jaw and first elongated extension shaft being linearly movable by the handle members relative to the second jaw and second elongated extension shaft between a first open position and a second clamped position, portions of the first and second jaws being substantially parallel to each other in the first open and second clamped positions and parallel through a range of tissue clamping spacing...."

With respect to independent claim 3, applicant has amended the claim to require in pertinent part, "the first grasping jaw extending from a first extension shaft and the second grasping jaw extending from a second extension shaft, the second extension shaft being slidably movable relative to the first extension shaft wherein the grasping jaws are relatively moveable between open and closed positions, portions of the jaws being substantially parallel to each other when in the closed position and at least portions of the jaws being parallel to each other through a range of clamping spacing...."

Thus, in both independent claims 1 and 3, applicant now requires that each of the first and second jaws extend from a respective extension shaft and are substantially parallel to each other, and in claim 1 that the first and second jaws and extension shafts are linearly movable relative to each other, and in claim 3 that the second extension shaft is slidably movable relative to the first extension shaft. These amendments are supported within the application, such as for example in the published application in the drawings in FIGS. 33-37 and in the text in paragraph nos. 0115-0123.

Independent claims 1 and 3 now distinguish over the scissor type structures and operative action of the prior art Yamauchi and Chen devices. These differences are important when one considers the placement of the surgical device and its operation. For instance, the device of applicants' claims permits a fixed jaw to be located adjacent a tissue to be grasped or clamped and then a movable jaw to be advanced to grasp or clamp the tissue. This construction and orientation of a surgical device provides a less intrusive, more steady approach than is provided by a scissor type device where both jaws move while being opened and closed.

Thus, even if Yamauchi and Chen could be combined, they fail individually or together to provide all of the recitations of independent claims 1 and 3. Yamauchi and Chen simply cannot be combined to meet all of the limitations of the independent claims, and it is respectfully submitted that these claims are patentable and the rejections in light of the prior art should be withdrawn. Also, given that the respective dependent claims 2 and 4-9 provide further limitations thereto, the prior art does not teach or suggest the limitations of these dependent claims and they too are patentable.

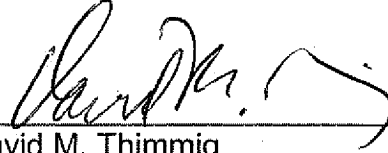
### **Conclusion**

Based on the foregoing amendments and remarks, it is respectfully submitted that all the pending claims 1-9 are in condition for allowance. If the examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the examiner is invited to contact the undersigned at the number identified below.

The Commissioner is hereby authorized to charge any amount due with this response to Deposit Account No. 50-1039.

Please refund any overpayments for this application to Cook Alex Ltd. at the address below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "David M. Thimmig", is written over a horizontal line.

David M. Thimmig  
Registration No. 34,036

COOK ALEX LTD.  
200 West Adams Street  
Suite 2850  
Chicago, Illinois 60606  
312-236-8500